

Serial No. 09/877,054  
Page 6

### REMARKS

In the Office Action, the Examiner notes that claims 1-8, 10-17 and 19-24 are pending in this Application. The Examiner further noted that claims 1-3 and 5-8 are allowed, that claims 4 and 10-17 are objected to and that claims 19-24 are rejected. By this response, claims 4, 10, 15, 19 and 24 are amended to correct for informalities pointed out by the Examiner and to more clearly define the invention of the Applicants and not in response to prior art. All other claims are unamended by this response.

In view of both, the above amendments and the following discussion, the Applicants respectfully submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Furthermore, the Applicants also respectfully submit that all of these claims are free of formality errors. Thus, the Applicants believe that all of these claims are now in allowable form.

### OBJECTIONS

The Examiner objected to claims 4, 10-17 and 24 because of the following informalities:

#### claim 4

The Examiner noted that in claim 4, line 2 "said network" seems to refer back to "said data packet network" in line 2 of claim 3 and as such should be changed to "said data packet network".

In response, the Applicants have amended claim 4 to recite "said data packet network" as suggested by the Examiner.

Having done so, the Applicants respectfully submit that the basis for the Examiner's objection to claim 4 has been removed. As such, the Applicants respectfully request that the Examiner's objection of claim 4 be withdrawn.

Serial No. 09/677,054  
Page 7

**claims 10-14**

The Examiner suggested that in claim 10 "for transporting signaling traffic" should be inserted after "a signaling link" in line 5 and that "for transporting voice traffic" should be inserted after "a voice path" in line 6, and that "said" should be inserted before "voice traffic" in line 7 and "signaling traffic" in line 8.

In response, the Applicants have amended claim 10 as suggested by the Examiner.

Having done so, the Applicants respectfully submit that the basis for the Examiner's objection to claims 10-14 has been removed. As such, the Applicants respectfully request that the Examiner's objections of claims 10-14 be withdrawn.

**claim 15-17**

The Examiner noted that in claim 15, line 2 "said network" seems to refer back to "said data packet network" in line 2 of claim 14 and as such should be changed to "said data packet network".

In response, the Applicants have amended claim 15 to recite "said data packet network" as suggested by the Examiner.

Having done so, the Applicants respectfully submit that the basis for the Examiner's objections to claim 15-17 has been removed. As such, the Applicants respectfully request that the Examiner's objections of claims 15-17 be withdrawn.

**claim 24**

The Examiner noted that in claim 24, line 1, "said digital signal portion" seems to refer back to "a digital signal processing portion" in line 8 of claim 19 and as such should be changed to "said digital signal processing portion".

In response, the Applicants have amended claim 24 to recite "said digital signal processing portion" as suggested by the Examiner.

299900-1

Serial No. 09/677,054  
Page 8

Having done so, the Applicants respectfully submit that the basis for the Examiner's objection to claim 15 has been removed. As such, the Applicants respectfully request that the Examiner's objection of claim 15 be withdrawn.

## **REJECTIONS**

### **A. 35 U.S.C. § 103**

The Examiner rejected claims 19-24 under 35 U.S.C. §103(a) as being unpatentable over Menon et al. (U.S. Patent No. 6,208,627, hereinafter "Menon") in view of Lehr et al. (U.S. Patent No. 6,643,566, hereinafter "Lehr"). The rejection is respectfully traversed.

The Examiner alleges that regarding claims 19 and 23, Menon discloses an apparatus comprising a data portion interfacing with a data network (125) and a cellular portion for interfacing with a wireless network (106); a user interface portion for interfacing with peripheral devices (102); and a digital signal processing portion (within CPE) coupled to data and cellular portions (see fig. 1, col. 4, lines 25-67). The Examiner correctly concedes however that Menon fails to disclose a battery backup portion for detecting power failure. As such, the Examiner cites Lehr for teaching the use of battery backup. The Examiner therefore alleges that it would have been obvious to a person skilled in the art to use battery backup as taught in Lehr. The Applicants respectfully disagree.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 U.S.P.Q. 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added).

Serial No. 09/677,054  
Page 9

As recited above and as conceded by the Examiner, Menon fails to teach, suggest or disclose each and every aspect of the Applicants' claim 19, which specifically recites:

"An apparatus for providing bifurcated voice and signaling data traffic over a network, the apparatus comprising:  
a data portion, for interfacing with a data network;  
a cellular portion, coupled to the data portion, for interfacing with a wireless network;  
a user interface portion, coupled to the data portion and cellular portion, for interfacing with peripheral devices;  
a Digital Signal Processing portion, coupled to the cellular portion and the data portion, for processing cellular and data information; and  
a battery backup portion, coupled to the digital signal processing portion, for detecting power failures, wherein upon the detection of a power failure, voice traffic is switched to a communication channel of said as signaling traffic."

There is absolutely no teaching, suggestion or disclosure in Menon for a battery backup portion. Even further, there is absolutely no teaching, suggestion or disclosure in Menon for a battery backup portion for detecting power failures as taught in the Applicants' Specification and claimed by at least the Applicants' claim 19. Even further still, Menon fails to teach suggest or make obvious a battery backup portion for detecting power failures "wherein upon the detection of a power failure, voice traffic is switched to a communication channel of said as signaling traffic" as taught in the Applicants' Specification and claimed by at least the Applicants' claim 19. Therefore, the Applicants submit that the teachings of Menon alone, do not suggest, teach or make obvious the invention of the Applicants at least with respect to claims 19-24.

The Applicants further submit that there is no suggestion or motivation to combine the teachings of Menon and Lehr in an attempt to teach the invention of the Applicants.

Serial No. 09/677,054  
Page 10

For prior art reference to be combined to render obvious a subsequent invention under 35 U.S.C. § 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Uniroyal v. Rudkin-Wiley, 5 U.S.P.SQ.2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined only if there is some suggestion or incentive in the prior art to do so. In re Fine, 5 U.S.P.SQ.2d 1596, 1599 (Fed. Cir. 1988). Hindsight is strictly forbidden. It is impermissible to use the claims as a framework to pick and choose among individual references to recreate the claimed invention Id. at 1600; W.L. Gore Associates, Inc., v. Garlock, Inc., 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983).

Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

The Applicants further submit that even if there was a motivation or suggestion to combine the references (which the Applicants believe that there is none), the teachings of the Lehr fail to bridge the substantial gap between the Menon reference and the Applicants' invention at least with respect to claims 19-24. Again, there is absolutely no teaching, suggestion or disclosure in Menon for, alone for an apparatus for providing bifurcated voice and signaling data over a network, the apparatus including "a battery backup portion, coupled to the digital signal processing portion, for detecting power failures, wherein upon the detection of a power failure, voice traffic is switched to a communication channel of said as signaling traffic" as taught in the Applicants' Specification and claimed in at least the Applicants' claim 19.

Likewise, there is absolutely no teaching, suggestion or disclosure in Lehr for "a battery backup portion, coupled to the digital signal processing portion, for detecting power failures, wherein upon the detection of a power failure, voice traffic is switched to a communication channel of said as signaling traffic" as

Serial No. 09/677,054  
Page 11

taught in the Applicants' Specification and claimed in at least the Applicants' claim 19. More specifically, Lehr teaches a system for generating, delivering and distributing electrical power to network elements over a data communication network infrastructure within a building, campus or enterprise. Lehr teaches that consolidating power distribution and data communications over a single network simplifies and reduces the cost of network element installation and provides a means of supplying uninterrupted or backup power to critical network devices in the event of a power failure. The invention includes power/data combiners that combine a data communication signal with a low frequency power signal. The combined signal is transported over the LAN infrastructure where a power/data splitter extracts the data signal and the power signal and generates two separate outputs. (See Lehr, Abstract).

The Examiner alleges that Lehr discloses the use of battery backup in specifically reciting:

"Further, for network devices to operate during partial or complete electrical power supply interruption or failure, each network device must either incorporate an internal battery backup system or must be connected to an Uninterruptable Power Supply (UPS). Depending on the application, such as with IP or LAN telephones, the number of network devices that must operate during building power failures may be very high.

Thus, it would be desirable to eliminate the need for each network device that does not operate from a battery to be connected to a source of AC utility power, i.e., a standard AC electrical receptacle, in addition to a network connection. This would significantly reduce the number of electrical cables, AC receptacles and associated connections thereby simplifying the installation of network devices. In addition, this would also provide a cost effective means for providing an uninterruptable power source to multiple network devices." (See Lehr, col. 1, lines 45-62).

As evident from the disclosure of Lehr referenced by the Examiner and recited above, Lehr simply teaches that for network devices to operate during partial or complete electrical power supply interruption or failure, each network device must either incorporate an internal battery backup system or must be connected to an Uninterruptable Power Supply (UPS). Lehr does not teach, suggest or

299900-1

Serial No. 09/677,054  
Page 12

make obvious a battery backup portion for detecting power failures as taught in the Applicants' Specification and claimed by at least the Applicants' claim 19. More specifically, the Applicants teach and claim that a battery backup portion is implemented to detect a local power failure and not just to provide an electrical supply for network devices. Even further still, Lehr fails to teach suggest or make obvious a battery backup portion for detecting power failures "wherein upon the detection of a power failure, voice traffic is switched to a communication channel of said as signaling traffic" as taught in the Applicants' Specification and claimed by at least the Applicants' claim 19. Therefore, the Applicants submit that the teachings of Lehr alone, or in any allowable combination with the teachings of Mennon, do not suggest, teach or make obvious the invention of the Applicants at least with respect to claims 19-24.

As such, the Applicants submit that claims 19-24, as they now stand, are not obvious in view of Mennon and Lehr, alone or in any allowable combination, and fully satisfy the requirements under 35 U.S.C. §103 and are patentable thereunder.

The Applicants reserve the right to establish the patentability of each of the claims independently in subsequent prosecution.

#### Applicants' Note

The Applicants would like to thank the Examiner for pointing out allowable subject matter, however, the Applicants respectfully submit that, as they now stand, all of the Applicants' claims are allowable over the prior art cited by the Examiner. The Applicants do agree with the Examiner, however, that claims 1-3 and 5-8 are allowable as they stand.

#### CONCLUSION

Thus, the Applicants respectfully submit that none of the claims presently in the application are obvious under the provisions of 35 U.S.C. § 103. Furthermore, the Applicants also respectfully submit that all of these claims are

Serial No. 09/677,054

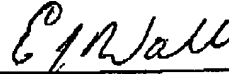
Page 13

free of formality errors . Consequently, the Applicants believe that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. Jorge Tony Villabon at (732) 530-9404 x1131 or Mr. Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

9/13/04



Eamon J. Wall  
Reg. No. 39,414  
(732) 530-9404

CUSTOMER #26,291  
Moser Patterson & SHERIDAN, LLP  
595 Shrewsbury Avenue, Suite 100  
Shrewsbury, New Jersey 07702  
732-530-9404 - Telephone  
732-530-9808 - Facsimile